UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,784	06/19/2000	James Crawford	06975-097001	4992

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EXAMINER
BAUGH, APRIL L

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-40 and 45-52_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-40 and 45-52_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _20040820_.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Response to Amendment

Claims 45 and 47 are amended; therefore claims 1-40 and 45-52 are pending.

Response to Arguments

Applicant's arguments with respect to claims 1, 14, 29-31, 36, and 45 have been considered but

are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-40 and 45-52 rejected under 35 U.S.C. 102(e) as being unpatentable by US

Patent No. 6,513,066 to Hutton et al.

Regarding claims 1, 29, and 31, Hutton et al. teaches a method, apparatus, and computer

program, stored on a computer readable medium for transferring a file from a first client

associated with a first subscriber to a communications system to a second client associated with a

second subscriber to the communications system, the method comprising: connecting from the

first client to a communications system host; sending, through the communications system host,

a request to the second client to establish a direct connection to the second client (column 7, lines 3-13 and 21-26); when the second client accepts the request (column 7, lines 34-40 and column 7, line 66 through column 8, line 14), establishing a direct connection to the second client that bypasses the communications system host; and transferring a file over the direct connection (column 8, line 50 through column 9, line 15).

Regarding claims 14, 30, and 36, Hutton et al. teaches a method, apparatus, and a computer program, stored on a computer readable medium for transferring a file from a first client associated with a first subscriber to a communications system to a second client associated with a second subscriber to the communications system, the method comprising: connecting from the second client to a communications system host; receiving, through the communications system host, a request from the first client to establish a direct connection (column 7, lines 3-13 and 21-26); accepting the request from the first client (column 7, lines 34-40 and column 7, line 66 through column 8, line 14); establishing a direct connection to the first client that bypasses the communications system host; and receiving a file over the direct connection (column 8, line 50 through column 9, line 15).

Referring to claim 45, Hutton et al. teaches a user interface configured to enable to acceptance or rejection of a file transfer from a first client associated with a first subscriber to a communications system to a second client associated with a second subscriber to the communications system, the user interface comprising: a first graphical user interface element structured and arranged to notify an operator of the second client of a request by the first client to establish a direct connection to the second client, the request being communicated to the second client by a communications system host and the direct connection bypassing the communications

system host (column 7, lines 3-13 and 21-26); and a second graphical user interface element

structured and arranged to enable an operator of the second client authorize the establishment of

the direct connection and a file transfer over the direct connection (column 7, lines 34-40 and

column 7, line 66 through column 8, line 14 and column 8, line 50 through column 9, line 15).

Regarding claims 2 and 15, Hutton et al. teaches the method of claim 1 and 14, wherein

the request is authenticated by the communications system host (column 11, lines 59-60).

Regarding claims 3 and 16, Hutton et al. teaches the method of claim 1 and 14, wherein

the second client accepts the request based on indicated preferences of the second subscriber

(column 6, lines 28-54).

Regarding claims 4 and 17, Hutton et al. teaches the method of claim 1 and 14, wherein

the direct connection is initiated by the second client (column 7, lines 66 through column 8, line

14).

Regarding claims 5 and 18, Hutton et al. teaches the method of claim 1 and 14, wherein

the direct connection to the second client is established using an IP address of the second client

(column 2, lines 20-25).

Regarding claims 6 and 19, Hutton et al. teaches the method of claim 1 and 14, further

comprising displaying a graphical user interface indicating that a direct connection to the second

client is established (column 8, lines 41-45).

Regarding claims 7 and 20, Hutton et al. teaches the method of claim 1 and 14, wherein

the communications system host comprises an instant messaging host (column 1, lines 19-21 and

46-48).

Regarding claims 8 and 21, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises a data file (column 4, lines 27-28).

Regarding claims 9 and 22, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises a text file (column 1, lines 40-42).

Regarding claims 10 and 23, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises a graphics file (column 1, lines 22-23).

Regarding claims 11 and 24, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises an audio file (column 1, lines 22-23).

Regarding claims 12 and 25, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises a video file (column 1, lines 22-23).

Regarding claims 13 and 28, Hutton et al. teaches the method of claim 1 and 14, wherein the direct connection is a socket connection (column 7, lines 21-22).

Regarding claim 26, Hutton et al. teaches the method of claim 14, further comprising receiving an indication that the first subscriber using the first client is composing a message (column 7, lines 36-39).

Regarding claim 27, Hutton et al. teaches the method of claim 26, further comprising receiving the message composed by the first subscriber from the first client (column 7, line 66 through column 8, lines 3).

Referring to claims 32 and 37, Hutton et al. teaches the method of claim 31 and 36 wherein the computer readable medium comprises a disc (column 4, lines 17-19 and 28-30).

Regarding claims 33 and 38, Hutton et al. teaches the method of claim 31 and 36 wherein the computer readable medium comprises a client device (column 3, lines 34-35).

Regarding claims 34 and 39, Hutton et al. teaches the method of claim 31 and 36 wherein

the computer readable medium comprises a host device (column 3, lines 34-35).

Regarding claims 35 and 40, Hutton et al. teaches the method of claim 31 and 36 wherein

the computer readable medium comprises a propagated signal (column 3, lines 17-21).

Regarding claim 46, Hutton et al. teaches the user interface of claim 45 wherein the first

graphical user interface element is a dialog box (Fig.5 & 6, column 9, lines 43-62 and column

10, line 40-column 11, line 3).

Referring to claim 47, Hutton et al. teaches the user interface of claim 45 wherein the

second graphical user interface element includes a set of sub elements selectable by the recipient

to authorize or reject establishment of the direct connection (Fig.5 & 6, column 9, lines 43-62

and column 10, line 40-column 11, line 3).

Regarding claim 48, Hutton et al. teaches the user interface of claim 47 wherein the sub

elements are option buttons (Fig.5 & 6, column 9, lines 43-62 and column 10, line 40-column 11,

line 3).

Referring to claim 49, Hutton et al. teaches the user interface of claim 47 wherein the sub

elements include a sub element selectable to authorize the direct connection (Fig.5 & 6, column

9, lines 43-62 and column 10, line 40-column 11, line 3).

Regarding claim 50, Hutton et al. teaches the user interface of claim 47 wherein the sub

elements include a sub element selectable to reject the direct connection (Fig.5 & 6, column 9,

lines 43-62 and column 10, line 40-column 11, line 3).

Referring to claim 51, Hutton et al. teaches the user interface of claim 47 wherein the sub

elements include a sub element selectable to ignore the request (Fig.5 & 6, column 9, lines 43-62

and column 10, line 40-column 11, line 3).

Regarding claim 52, Hutton et al. teaches the user interface of claim 47 wherein the sub

elements include a sub element selectable to warn the first client not to send future requests for a

direct connection to the second client (Fig.5 & 6, column 9, lines 43-62 and column 10, line 40-

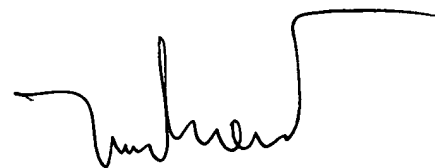column 11, line 3).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to April L Baugh whose telephone number is 703-305-5317. The

examiner can normally be reached on Monday-Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Rupal Dharia can be reached on 703-305-4003. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER